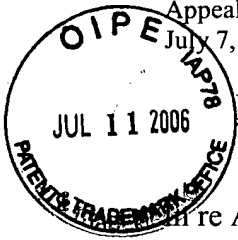


AF  
JFW

Docket No. 10005.000120

Appeal Brief

July 7, 2006



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

in re Application of:

Jax B. Cowden et al.

Application No.: 09/993,906 Examiner: Divecha, Kamal B.

Filing Date: November 27, 2001 Art Unit: 2151

Assignee: Claria Corporation

Title: METHOD AND APPARATUS FOR DISTRIBUTING A COMPUTER PROGRAM

Honorable Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPEAL BRIEF FILED UNDER 37 C.F.R. § 41.37**

Sir:

This appeal brief follows the Notice of Appeal filed by Applicants on July 6, 2006.

A check covering the fee for filing an appeal brief is submitted herewith. If for any reason the check is insufficient or additional fees are required, the Commissioner is hereby authorized to charge the insufficiency to Deposit Account No. 50-2427.

**I. REAL PARTY IN INTEREST**

The real party in interest is Claria Corporation of Redwood City, California, which is the assignee of the present application.

07/12/2006 TBESHAH1 00000033 09993906

01 FC:2402

250.00 0P

**II. RELATED APPEALS AND INTERFERENCES**

On information and belief, there are no appeals, interferences, or judicial proceedings known to the appellant, the appellant's legal representative, or assignee

which may be related to, directly affect or be directly affected by or have a bearing on the Board of Patent Appeals and Interferences decision in the pending appeal.

### III. STATUS OF CLAIMS

Claims 1 and 3-9 are pending in this application and stand finally rejected.

Claims 1 and 3-9 are being appealed. These claims are rejected in the final office action mailed May 15, 2006 ("last office action").

### IV. STATUS OF AMENDMENTS

No amendment has been filed after the last office action.

### V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter relates to distribution of computer programs over computer networks.

In independent claim 1, a partially disabled computer program is installed in a computer (Specification, page 29, line 20 to page 30 line 4; FIG. 10, action 1002). Among other advantages, this minimizes the impact of the computer program on the storage and computing resources of the computer until the computer program is subsequently accepted by the offer (Specification, page 29, lines 21-22). The computer program is offered to the user after the computer program has been installed in the computer (Specification, page 30, lines 8-13; FIG. 10, action 1008). Claim 1 requires the computer program to be provided to the user after the user accepts the offer (Specification, page 31, lines 1-5; FIG. 10, action 1010), which as recited is after the installation of the computer program. The user is informed of the usefulness of the computer program when the user tries to uninstall the computer program (Specification, page 30, lines 18-20). Reminding the user of the efficacy of the computer program at a

time when the user is trying to uninstall it advantageously increases the chance of the user keeping the program (Specification, page 30, lines 20-23).

In independent claim 7, a partially disabled computer program is installed in a computer (Specification, page 29, line 20 to page 30 line 4; FIG. 10, action 1002). The efficacy of the computer program is then demonstrated to the user (Specification, page 30, lines 5-13; FIG. 10, actions 1004 and 1006). The computer program is offered to the user after the computer program has been installed in the computer (Specification, page 30, lines 8-13; FIG. 10, action 1008). The computer program is fully activated after the user accepts the offer (Specification, page 31, lines 1-5; FIG. 10, action 1010). The user is informed of the usefulness of the computer program when the user tries to uninstall the computer program (Specification, page 30, lines 18-20) after acceptance of the offer.

## VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

To following grounds of rejection are to be reviewed on appeal:

a) Rejection of claims 1, 4, and 7 under 35 U.S.C. § 103(a) as being unpatentable over InfoWorld in view of Quarterdeck.

b) Rejection of claims 3, 6, 8, and 9 under 35 U.S.C. §103(a) as being unpatentable over InfoWorld in view of Quarterdeck and further in view of U.S. Patent No. 5,996,011).

c) Rejection of claim 5 under 35 U.S.C. § 103(a) as being unpatentable over InfoWorld Publishing in view of Quarterdeck and further in view of Cinecom.

## VII. ARGUMENTS

The aforementioned grounds of rejection are respectfully traversed.

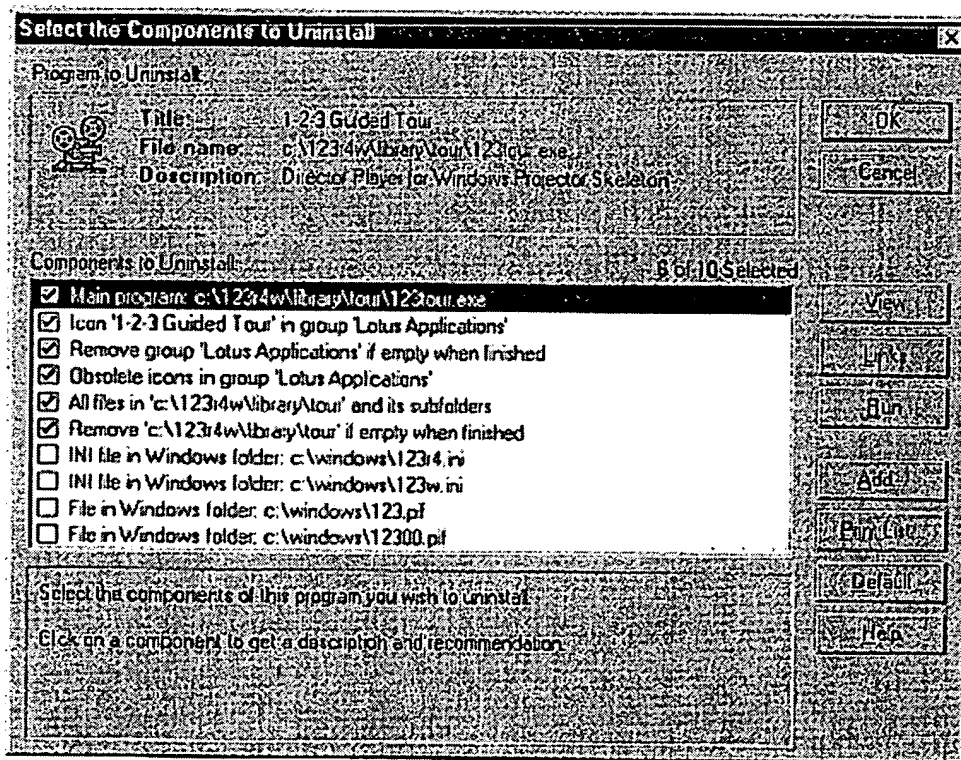
### A. CLAIMS 1, 4, and 7

Claims 1, 4, and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over InfoWorld (InfoWorld Publishing, "Release Software and Demo 97 DemoLetter to

Provide Real Demos online,” pp. 1-2, February 1997) (“InfoWorld”) in view of Quarterdeck (“CleanSweep 95 Reviewer’s Guide,” dated 10/30/2001).

There are three requirements to establish a prima facie case of obviousness. First, there must be some suggestion or motivation to modify a reference or to combine references. Second, there must be a reasonable expectation of success. Third, the prior art reference or combined references must teach or suggest all the claim limitations. See MPEP § 2143.

Claim 7 is patentable over the combination of InfoWorld and Quarterdeck at least for reciting: “informing the user of usefulness of the computer program when the user tries to uninstall the computer program after accepting the offer.” As noted in the last office action, InfoWorld does not disclose this limitation. The last office action suggests that Quarterdeck discloses this limitation on page 9, noting that “selecting and clicking on a file or program provides the description and usefulness of program.” Applicants respectfully disagree with this conclusion.



The uninstall window shown in Quarterdeck page 9 is reproduced above. It is respectfully submitted that page 9 of Quarterdeck does not teach or suggest **reminding the user of the usefulness** of a computer program to be uninstalled. In fact, it is highly unlikely for Quarterdeck to be able to do so given that it does not even run the programs to be uninstalled. The most Quarterdeck can do is give a description of the program and how safe it is to remove the program from the computer. This is actually the case because all Quarterdeck does when the View button is clicked is to allow the user “to check the contents of the files that are candidates for deletion” (Quarterdeck page 9). The “description” provided by Quarterdeck is thus nothing more than telling the user what the program is for safety reasons, not to remind the user of the usefulness of the computer program (Quarterdeck, page 8).

Therefore, it is respectfully submitted that claim 7 is patentable over the combination of InfoWorld and Quarterdeck.

Claim 1 is rejected using the same rationale as that given for claim 7. Therefore, claim 1 is patentable over the combination of InfoWorld and Quarterdeck at least the same reasons given for claim 7. Claim 4 is patentable over the combination of InfoWorld and Quarterdeck at least for depending on claim 1.

B. CLAIMS 3 and 9

Claims 3 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over InfoWorld in view of Quarterdeck and further in view of U.S. Patent No. 5,996,011 to Humes (“Humes”).

Claim 3 is patentable over the combination of InfoWorld, Quarterdeck, and Humes at least for reciting: “wherein the act of informing the user of usefulness of the computer program includes informing the user a number of a type of **window** detected by the computer program” (emphasis added). As will be demonstrated below, the combination of InfoWorld, Quarterdeck, and Humes does not teach or suggest keeping track of the number and types of windows in a computer. Furthermore, there is no suggestion or motivation to combine Humes with InfoWorld and Quarterdeck to meet all the limitations of claim 3.

1. Humes does not disclose detection and tracking of types of windows.

As noted in the last office action, neither InfoWorld nor Quarterdeck teaches or suggests informing the user the number and type of windows detected by the computer program being uninstalled. The last office action suggests, however, that Humes discloses this limitation.

Humes detects contents received from web sites (i.e. web page) by URL. The last office action thus appears to be reading “website or web page as a type of window.” Applicants respectfully disagree with this conclusion. A window in the context of computers is a notoriously well understood term. Humes cannot and does not detect types of windows; Humes can only detect contents and source of contents (i.e., information) displayed in a window (a browser window), not the type of the window itself. The specification provides:

In the present disclosure, the term “window” is used to refer to any mechanism for presenting information to a user. Thus, the term “window” also includes message boxes, dialog boxes, text boxes, banners, etc. A window may be associated with a web browser, or may be generated as a result of receiving information from another computer over a computer network or from a local computer program. Specification, page 5, line 19 to page 6, line 1.

The above is consistent with the common usage of the term “window.” Note, however, that a mechanism for presenting information is not the information itself. Here, a web page of a website is merely information and cannot be used to present itself (i.e., the information). A web page needs to be included in a window to be presented to a user. Humes does not disclose detecting types of windows, let alone informing the user the number of a type of window detected.

Even in the improper construction that content is “a window” (it is not), Humes does not teach or suggest informing the user of **the number** of “types of websites or web pages” that have been filtered. While Humes uses a scoring system to determine whether to filter a web page, **the score itself is never presented to the user for any purpose.** Therefore, it is respectfully submitted that claim 3 is patentable over InfoWorld, Quarterdeck, and Humes. Claim 9 is patentable over InfoWorld, Quarterdeck, and Humes for similar reasons.

2. There is no suggestion or motivation to combine Humes with InfoWorld and Quarterdeck.

When read with claim 1, claim 3 requires that the user is informed of the number and type of windows detected by the computer program being uninstalled by the user. In the context of the rejection, this necessarily requires Quarterdeck to be modified with Humes such that Quarterdeck informs the user of the number and type of web pages detected by Humes' content-filtering program, which is being uninstalled. However, Quarterdeck cannot do this as it is a generic uninstaller (its key selling point) for the Windows Operating system. Quarterdeck does not run the program it is uninstalling or communicates with that program to learn of the number and type of detected web pages, if any. That is, there is no teaching in InfoWorld, Quarterdeck, or Humes to inform the user of the number and type of windows detected by a computer program, especially at a time when the user uninstalls that computer program. Such a teaching is only in the present disclosure – not in any of the references of record. Therefore, it is respectfully submitted that claim 3 is patentable over the combination of InfoWorld, Quarterdeck, and Humes. Claim 9 is patentable over InfoWorld, Quarterdeck, and Humes for similar reasons.

C. CLAIMS 6 and 8

Claims 6 and 8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over InfoWorld in view of Quarterdeck and further in view of Humes.

Claim 6 is patentable over the combination of InfoWorld, Quarterdeck, and Humes at least for reciting: “wherein the computer program includes a window-blocking computer program.” As noted in the last office action, InfoWorld in view of Quarterdeck does not disclose a window-blocking computer program. The last office action suggests, however, that Humes discloses such a program. Applicants respectfully disagree with this conclusion.

Humes col. 2, line 31 to col. 3, line 22 and col. 4, lines 10-20, cited in the last office action, discuss filtering of web pages, **not the window** where the web page is displayed. That is, Humes discloses content (e.g., web page) filtering, not blocking of windows (e.g., browser, pop-up). As explained above, content is not the same as the

window where the content is displayed. For example, Humes cannot block proliferation of pop-up windows. Therefore, it is respectfully submitted that claim 6 is patentable over the combination of InfoWorld, Quarterdeck, and Humes. Claim 8 is patentable over InfoWorld, Quarterdeck, and Humes for similar reasons.

D. CLAIM 5

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over InfoWorld in view of Quarterdeck and further in view of Cinecom, document #1043564 (“Cinecom”).

Claim 5 is patentable over InfoWorld, Humes, and Cinecom at least for reciting: “wherein the act of providing the computer program to the user includes downloading **components** of the computer program from a remote computer” (emphasis added). Note that per claim 1, this downloading of components of the computer program occurs after the user accepts the offer, which occurs after installation of the computer program.

As noted in the last office action, InfoWorld and Quarterdeck do not disclose the process wherein the act of providing the computer program to a user includes downloading components of the computer program from a remote computer. Neither does Cinecom. Cinecom only discloses downloading **trial or full versions** of a computer program, not **components** of the computer program from a remote computer. More specifically, Cinecom does not teach or suggest downloading from a remote computer, components of a trial version or full version of a computer program after the trial version or the full version of the computer program has been accepted by the user, which offer must occur after the trial version or the full version of computer program has already been installed in the computer beforehand.

For at least the above reasons, claim 5 is patentable over InfoWorld, Quarterdeck, and Cinecom.

E. CLAIMS 1 and 3-9 (Prior Art Status of Quarterdeck)

Quarterdeck appears to discuss the features of CleanSweep 95 as it existed in October 30, 2001, which is the date of the document cited in the rejection. With a filing



Docket No. 10005.000120  
Appeal Brief  
July 7, 2006

date of November 27, 2001, it is believed that Quarterdeck is not prior art to the present application. It is well established that references cited in an obviousness rejection under 35 U.S.C. § 103 must be prior art to the application. Accordingly, it is respectfully submitted that claims 1 and 3-9 are patentable.

#### VIII. CLAIMS INVOLVED IN THE APPEAL

The claims involved in the appeal are included in the Claims Appendix submitted herewith.

#### IX. CONCLUSION

For at least the above reasons, allowance of claims 1 and 3-9 is respectfully requested.

Respectfully submitted,  
Jax B. Cowden et al.

Dated: 7/7/2006

*Patrick Benedicto*

Patrick D. Benedicto, Reg. No. 40,909  
Okamoto & Benedicto LLP  
P.O. Box 641330  
San Jose, CA 95164  
Tel.: (408)436-2110  
Fax.: (408)436-2114

| CERTIFICATE OF MAILING   |                          |        |              |
|--|--------------------------|--------|--------------|
| I hereby certify that this correspondence, including the enclosures identified herein, is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below. If the Express Mail Mailing Number is filled in below, then this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service pursuant to 37 CFR 1.10. |                          |        |              |
| Signature:   | <i>Patrick Benedicto</i> |        |              |
| Typed or Printed Name:   | Patrick D. Benedicto     | Dated: | July 7, 2006 |
| Express Mail Mailing Number (optional):  |                          |        |              |

CLAIMS APPENDIX

CLAIMS INVOLVED IN THE APPEAL

1. A method to be performed in a computer, the method comprising:  
installing a computer program in the computer, the computer program being partially disabled as installed;  
offering the computer program to the user after installation of the computer program in the computer;  
providing the computer program to the user after the user accepts the offer; and  
informing the user of usefulness of the computer program when the user tries to uninstall the computer program after accepting the offer.
3. The method of claim 1 wherein the act of informing the user of usefulness of the computer program includes informing the user a number of a type of window detected by the computer program.
4. The method of claim 1 wherein the act of providing the computer program to the user includes activating the computer program.
5. The method of claim 1 wherein the act of providing the computer program to the user includes downloading components of the computer program from a remote computer.
6. The method of claim 1 wherein the computer program includes a window-blocking computer program.
7. A method to be performed in a computer, the method comprising:  
installing a computer program in the computer, the computer program being partially disabled as installed;  
demonstrating the efficacy of the computer program to a user;  
offering the computer program to the user after installation of the computer program in the computer;  
fully activating the computer program only after the user accepts the offer; and  
informing the user of usefulness of the computer program when the user tries to uninstall the computer program after accepting the offer.
8. The method of claim 7 wherein the computer program includes a computer program for blocking a certain type of window.
9. The method of claim 7 wherein the act of demonstrating the efficacy of the computer program to the user includes informing the user of the number of windows of a certain type detected by the computer program.

EVIDENCE APPENDIX

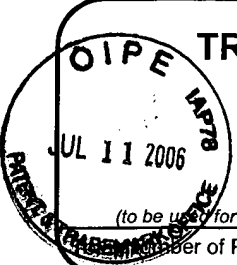
There are no documents or items submitted under this section.

Docket No. 10005.000120  
Appeal Brief  
July 7, 2006

RELATED PROCEEDINGS APPENDIX

There are no documents or items submitted under this section.

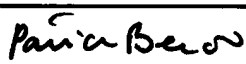
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

|   |                      |                        |              |
|---|----------------------|------------------------|--------------|
|  <p><b>TRANSMITTAL FORM</b></p> <p>(to be used for all correspondence after initial filing)</p> | Application Number   | 09/993,906             |              |
|   | Filing Date          | November 27, 2001      |              |
|   | First Named Inventor | Jax B. Cowden          |              |
|   | Art Unit             | 2151                   |              |
|   | Examiner Name        | Divecha, Kamal B       |              |
| Number of Pages in This Submission  | 13                   | Attorney Docket Number | 10005.000120 |

**ENCLOSURES (check all that apply)**


|   |  |   |                |
|---|--|---|----------------|
| <input type="checkbox"/> Fee Transmittal Form<br><input checked="" type="checkbox"/> Fee Attached<br><input type="checkbox"/> Amendment / Reply<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input type="checkbox"/> Information Disclosure Statement<br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Reply to Missing Parts/ Incomplete Application<br><input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><input type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a Provisional Application<br><input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address<br><input type="checkbox"/> Terminal Disclaimer<br><input type="checkbox"/> Request for Refund<br><input type="checkbox"/> CD, Number of CD(s) _____<br><input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC<br><input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences<br><input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):<br>Return Receipt Postcard |                |
| <table border="1"> <tr> <td><b>Remarks</b></td> </tr> </table>  |  |   | <b>Remarks</b> |
| <b>Remarks</b>  |  |   |                |

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

|              |   |          |        |
|--------------|---|----------|--------|
| Firm         | Okamoto & Benedicto LLP   |          |        |
| Signature    |  |          |        |
| Printed Name | Patrick D. Benedicto  |          |        |
| Date         | July 7, 2006  | Reg. No. | 40,909 |

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

|                       |   |      |              |
|-----------------------|---|------|--------------|
| Signature             |  |      |              |
| Typed or printed name | Patrick D. Benedicto  | Date | July 7, 2006 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.